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33. (New) The method of claim 32 wherein the cavity is shaped so that the ridge has at least one wall obtusely angled with respect to an adjoining portion of the side wall so that a gap is formed between ridges of the two shells when they are nested.

34. (New) The method of claim 30 wherein the cavity is shaped so that the upwardly extending walls include a ridge below the cut lip, the ridge protruding away from the volume and extending around the entire periphery of the upwardly extending walls.

#### REMARKS

Reconsideration of the present application is respectfully requested.

Claim 28 has been amended to remove the words "the steps of" from the preamble.

Dependent claims 29-34 have been added.

#### The rejections under 35 U.S.C. §103.

Claim 28 was rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,418,690 to Edwards in view of U.S. Patent No. 4,495,135 to White. Applicant disagrees with this rejection for the following reasons: (1) the proposed modification renders the prior art unsatisfactory for its intended purpose; and (2) the proposed modification would change the principle of operation of a reference.

**The proposed modification renders the prior art unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified**

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unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01 citing *In re Gordon* 221 USPQ 1125 (CAFC 1984).

The Office Action proposes incorporating the separable first and second mold portions as taught by White into the mold of Edwards in order to facilitate removal of the container. White discloses a molding cavity 28 defined by a flange-forming portion 33 which includes a leading end 39 (Figures 3-8; column 4, lines 20-41). This leading end 39 and lower die member 23 together form portion 43 of flange 44 of container 24 (Figures 3 and 4, and Figures 6 and 7; column 4, lines 41-45). As best seen in Figures 3 and 6, leading end 39 and die member 23, which are separable from one another, come together at flange 44 of the container. In order to remove the web 30 of containers 24, leading end 39 is moved away from, or parted, from lower die 23 (Figures 4 and 7).

This parting of adjacent mold members around the flange of the containers is an unsatisfactory modification to the disclosure of Edwards. Edwards notes the problems in obtaining a smooth rim structure on a container (column 1, lines 35-39). White notes that having a mold parting line on the peripheral edge of a container is a "disability" and is "particularly undesirable in containers . . . used for ordinary drinking purposes" (column 1, lines 44-50). He states that his invention is "directed toward solving the problem of providing a smooth curvilinear bead upon the peripheral edge of a molded article, the bead being provided without a parting line" (column 1, lines 57-60, emphasis added).

Thus, the proposed combination of incorporating the separable first and second portions of White's mold into the mold of Edwards would create on the finished container the undesirable rough parting line noted by Edwards. This proposed combination would render Edwards unsatisfactory for its intended purpose of providing a bead on a container without a parting line.

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Since the proposed addition of White's first and second mold portions into the mold of Edwards would render Edwards unsatisfactory for its intended purposes, there can be no suggestion or motivation to make this modification. Lacking the suggestion or motivation to make the modification, a *prima facia* case of obviousness cannot be established and Applicant respectfully request withdrawal of the rejection of claim 28.

**The proposed modification cannot change the principle operation of a reference.** If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facia* obvious. MPEP §2143.01 citing *In re Ratti* 123 USPQ 349 (CCPA 1959). The Office Action proposes incorporating the separable first and second mold portions as taught by White into the mold of Edwards. However, White's molding apparatus operates so differently than Edwards' molding apparatus that Applicant is unaware how the proposed combination can be made without changing several principles of operation in Edwards.

Edward discloses a molding apparatus which produces a single, separated molded article (column 3, lines 59-67; Figure 10). Each container is separately die-sheared from a web by moving upper and lower molds towards each other (column 3, lines 48-52). The finished article is removed from the apparatus by pushing the article from the bottom out of the mold (column 3, lines 59-68; Figure 10). Further, the thermoplastic material is forced into engaging the mold by means of a positive pressure (column 3, lines 35-47).

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In contrast, White discloses a molding apparatus which is significantly different. White's molding apparatus produces a web of 30 of joined containers which are subsequently sealed as a web (column 4, lines 5-15). White does not disclose any means for separating the containers.

After the web of containers is formed, the molds are lowered away from the web "so that movement of the web 30 of container members . . . will not be interfered with by the leading end 39 of the gate assembly 41" (column 5, lines 1-10, Figures 5 and 8). White moves the mold away from the web; Edwards moves the individual container away from the mold. Further, the thermoplastic material of White is moved into conformity with the mold by use of vacuum manifolds (column 4, lines 26-38).

Given so many significant differences in operation, Applicant is unaware how the proposed combination can be made without changing at least one principle of operation of Edwards. As one example of incompatibility, it is not known how the separable mold portion of White (leading end 39) could be compatible with the die-shearing operation of Edwards. Also, the mold portions of White are intended to move downward and away from the web of containers. Applicant is unaware, and the Office Action is silent, as to how these downwardly-moving mold portions of White would be incorporated into the static mold of Edwards. The Office Action does not indicate any specifics as to how these two very different disclosures can be combined.

The Office Action proposes taking first and second mold portions from the disclosure of White (which is directed toward the fabrication of a web of unseparated containers, held stationery as the mold moves, and vacuum formed) into the mold of Edwards (which is directed toward fabrication of separate die-cut containers which are pushed out of a static die, and formed by positive pressure). However, the proposed modification would change one or more principles

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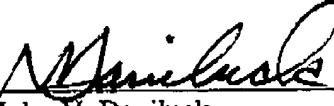
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of operation of Edwards, and therefore a *prima facia* case of obviousness cannot be established. Applicant respectfully request withdrawal of the rejection of claim 28.

### CLOSING

Applicant has amended claim 28 and added new dependent claims 29-34. Applicant respectfully request reconsideration of pending claims 28-34 of the present application. The undersigned welcomes a telephonic interview with the Examiner, if the Examiner believes that such an interview would facilitate resolution of any outstanding issues.

Respectfully submitted,

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